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(Formalities and other matters)



Application No. 05 748 223.4 - 1241	Ref. BB 58487	Date 12.07.2007
Applicant SCIENTIFIC-ATLANTA, INC.		

Communication pursuant to Article 96(2) EPC

The examination of the above-identified application has revealed that it does not meet the requirements of the European Patent Convention for the reasons enclosed herewith. If the deficiencies indicated are not rectified the application may be refused pursuant to Article 97(1) EPC.

You are invited to file your observations and insofar as the deficiencies are such as to be rectifiable, to correct the indicated deficiencies within a period

of 4 months

from the notification of this communication, this period being computed in accordance with Rules 78(2) and 83(2) and (4) EPC.

One set of amendments to the description, claims and drawings is to be filed within the said period on separate sheets (Rule 36(1) EPC).

Failure to comply with this invitation in due time will result in the application being deemed to be withdrawn (Article 96(3) EPC).



Dobbelaere, Dirk
Primary Examiner
for the Examining Division

Enclosure(s): 3 page/s reasons (Form 2906)



The examination is being carried out on the **following application documents**:

Description, Pages

1-13 as originally filed

Claims, Numbers

1-16 as originally filed

Drawings, Sheets

1-4 as originally filed

- 1 An International Preliminary Report on Patentability has already been drawn up for the present application in accordance with the PCT. The deficiencies mentioned in that report give rise to objections under the corresponding provisions of the EPC.

In summary, it appears that:

- 1.1 Independent claim 1, and corresponding further independent claims 10 and 15 cannot be considered inventive in view of D1 and D2 as detailed in the International Preliminary Report on Patentability;
- 1.2 Dependent claims 2-9, 11-14 and 16 do not appear to disclose any further particular features that could lead to a novel and inventive claim in view of the prior art in D1 and D2 as cited in the International Search Report.
- 2 Additionally, the application does also not meet the requirements of the EPC in the following respects:

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- 2.1 Claim 1 discloses a *network overlay system*: the term *overlay* is not clear nor well-defined in the description or claims, nor is it well-known in the art. This results in an overall unclear set of claims, Art 84 EPC;
- 2.2 On pages 1, 2, 6, 8 and 12 several further prior art documents are referred to, and incorporated *by reference* into the present application. Such an incorporation *by reference* should however be avoided, see Guidelines C-II, 4.18;
- 2.3 Furthermore, several of these documents are identified only by their US Patent Application serial no. This should be replaced by the corresponding publication no. insofar this is available;
- 2.4 Furthermore, the vague and imprecise statement in the description on page 12, line 28 - page 13, line 2 implies that the subject-matter for which protection is sought may be different to that defined by the claims, thereby resulting in lack of clarity of the claims (Article 84 EPC) when used to interpret them (see the Guidelines, C-III, 4.3a). This statement should therefore be amended to remove this inconsistency.
- 3 Considering the objections above, and in view of the available prior art in documents D1 and D2, it is not at present apparent which part, if any, of the application could serve as a basis for a new, allowable claim. Should the applicant nevertheless regard some particular matter as patentable, an independent claim should be filed taking account of Rule 29(1) EPC.

If and when filing new claims, and also in order to meet the requirements of Rule 27(1)(b) EPC, the documents D1-D2 should be identified in the description and their relevant contents should be indicated. The applicant should ensure that it is clear from the description which features of the subject-matter of a newly drafted independent claim are known from these documents.

It is also strongly advised to clearly detail the features which, in view of the applicant,

**Bescheld/Protokoll (Anlage)****Communication/Minutes (Annex)****Notification/Procès-verbal (Annexe)**

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would render such a new independent claim novel over the available art, and what the technical contribution of such features is, relevant for the assessment of inventive step.

In order to facilitate the examination of the conformity of the amended application with the requirements of Article 123(2) EPC, the applicant should clearly identify the amendments carried out, irrespective of whether they concern amendments by addition, replacement or deletion, and to indicate the passages of the application as filed on which these amendments are based (see Guidelines E-II, 1).

If the applicant regards it as appropriate these indications could be submitted in handwritten form on a copy of the relevant parts of the application as filed.

Amendments should be made by filing replacement pages. Unnecessary recasting of the description should be avoided. An amended abstract is not required. The applicant should also take account of the requirements of Rule 36(1) EPC. If handwritten amendments are submitted, they should be clearly legible for the printer.

According to the decision of the President of the EPO under Rule 35(2) EPC (OJ EPO 12/2001, 563) one set of the amended documents of the European patent application shall be provided.